

Appl. No. 10/727,794
Amendment and Response to First Office Action

Attmy Docket No. 3539

REMARKS

All claims remain pending in the application. Claims 1, 2, 4-9, 11, 14, 15, 17 and 21 have been objected to because of informalities. Claims 1, 8, 15, 19 and 20 have been rejected under 35 U.S.C. 112. No disposition has been stated for claims 3, 10-13, 16 and 18.¹ However, the Applicant notes that claims 3, 10-13, 16 and 18 depend from claims the Examiner has objected to and rejected. The Applicant assumes from the record that claims 3, 10-13, 16 and 18 would be allowable if the grounds for objection and rejection of independent claims 1, 8 and 15 are overcome. Claims 1, 2, 4-9, 11, 14, 15, 17 and 21 have been amended. Reconsideration of the amended application is requested.

I. Claim Objections

With respect to claims 1, 2, 4-7 and 17, the Examiner states that "applicant has not properly defined what CENV is." Applicant respectfully disagrees and directs the Examiner to Applicant's "Definition of Terms" section found in the written description beginning at page 2. CENV is expressly defined on page 2 as "Contemporaneous Exchange for New Value." Applicant contends that there is no reason related to patentability that would require the substitution of "contemporaneous exchange for new value" in place of CENV in claims 1, 2, 4-7 and 17 since the modification would not represent a change in the scope of the claims. For the sole purpose of convenience to the public, Applicant has amended the claims as requested by the Examiner.

¹ Claim 11 has not been objected to in the "Disposition of Claims" section of the Office Action Summary. However, the Examiner's Detailed Action states an objection to claim 11 which is addressed by the Applicant below.

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With respect to claims 8, 9, 11, 14, 15 and 21, the Examiner states that "applicant has not properly defined what OCB is." Applicant respectfully disagrees and directs the Examiner to Applicant's "Definition of Terms" section found in the written description beginning at page 2. OCB is expressly defined on page 5 as "Ordinary Course of Business." Applicant contends that there is no reason related to patentability that would require the substitution of "ordinary course of business" in place of OCB in claims 8, 9, 11, 14, 15 and 21 since the modification would not represent a change in the scope of the claims. For the sole purpose of convenience to the public, Applicant has amended the claims as requested by the Examiner.

II. Claim Rejections Under 35 U.S.C. 112 (first paragraph)

Claims 1, 8 and 15 have been rejected as failing to comply with the enablement requirement with respect to the terms "in a data processing medium" and "creating in a data processing medium" which are present in each of the claims. Applicant respectfully disagrees with the Examiner's conclusion.

"When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement."

In re Wright, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993).

Applicant contends that the Examiner has not met the PTO's initial burden because no reasonable explanation has been provided. The office action does not contain any citation to the

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specification despite the fact that the data processing medium is expressly described in several places.

For example, at page 18 of the written description, Applicant identifies the disclosed methods as "software enabled" under the Summary of the Inventions. This idea is expanded by the Applicant in the detailed description in places such as pages 26-27 which state that "the inventions will utilize a format and type of data processing media 16 that allows for data input, manipulation, calculation and output display." Further still, the Applicant provides examples of data processing media on page 27 including, among others, "an electronic spreadsheet," "a database," "a computer" or "other means as are known in the art that allow the manipulations, calculations, and output display required by the inventions." These examples and more are also depicted graphically by the Applicant in Figs. 10, 12 and 18 (among others).

The Applicant contends that the function and operation of data processing "media" (the plural form of "medium" as used in the claims) including commercially available products such as Excel, Quattro Pro and Lotus 1-2-3 are well known to the public at large and even better known to persons of ordinary skill in the art. Additional enablement and exposition of the data processing medium is provided by dependent claims 3, 10 and 16 where spreadsheet software and database software are identified as data processing media.

For the reasons set forth above, the Applicant traverses the enablement rejection without amendment or other modification of the specification or claims.

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III. Claim Rejections Under 35 U.S.C. 112 (second paragraph)

Claim 1 has been rejected under the second paragraph of 35 U.S.C. 112 for the stated reason that there is insufficient antecedent basis for the limitation “the contemporaneous exchange for new value.” The claim term quoted by the Examiner appears only in the preamble of claim 1 and not elsewhere in the claim. Applicant has had some difficulty understanding the Examiner’s rejection but believes that the problem lies with the use of definite article “the” as opposed to the indefinite article “a.” Applicant has amended claim 1 to reflect this change.

Claims 8 and 15 have been rejected under the second paragraph of 35 U.S.C. 112 for the stated reason that there is insufficient antecedent basis for the limitation “the ordinary course of business.” Applicant believes that the problem again lies with the use of definite article “the” as opposed to the indefinite article “an.” Applicant has amended claims 8 and 15 to reflect these changes.

Claims 15, 19 and 20 have been rejected under the second paragraph of 35 U.S.C. 112 for the stated reason that there is insufficient antecedent basis for the limitation “the subsequent new value.” Applicant believes that the problem again lies with the use of definite article “the” as opposed to the indefinite article “a.” Applicant has amended claims 15, 19 and 20 to reflect these changes.

IV. Drawings

The Examiner has requested corrected drawings for Figures 1-9, 11-12, 14, 19-23 and 26-27 to correct “improper shading, handwritten text or text which is too small.” Revised drawings for each of the cited figures are enclosed with this response.

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V. Conclusion

For the reasons stated above, Applicant believes that all pending claims are in condition for allowance. In view of the foregoing amendments and remarks, the Applicant respectfully requests reconsideration and allowance of the pending claims.

Respectfully submitted,

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